



<b>DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION (37 CFR 1.63)</b>	Attorney Docket Number	42P17342
	First Named Inventor	Jianping Xu
	<b>COMPLETE IF KNOWN</b>	
	Application Number	10/816,026
	Filing Date	March 31, 2004
	Art Unit	
<input type="checkbox"/> Declaration Submitted with Initial Filing	OR	<input checked="" type="checkbox"/> Declaration Submitted after Initial Filing (surcharge (37 CFR 1.16(e)) required)
Examiner Name		

As a below named inventor, I hereby declare that:

My residence, mailing address, and citizenship are as stated below, next to my name.

I believe the inventor(s) named below to be the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

**METHOD AND APPARATUS FOR OPTICAL SIGNALING**

*(Title of the Invention)*

the specification of which

☐ is attached hereto.

OR

☒ was filed on (if applicable):

or 03/31/2004

as United States Application Number

10/816,026

PCT International Application Number

and was amended on

(if applicable)

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claim(s), as amended by any amendment specifically referred to above.

I do not know and do not believe that the claimed invention was ever known or used in the United States of America before my invention thereof, or patented or described in any printed publication in any country before my invention thereof or more than one year prior to this application. I do not know and do not believe that the claimed invention was in public use or on sale in the United States of America more than one year prior to this application, nor do I know or believe that the invention has been patented or made the subject of an inventor's certificate issued before the date of this application in any country foreign to the United States of America on an application filed by me or my legal representatives or assigns more than twelve months (for a utility patent application) or six months (for a design patent application) prior to this application.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

Docket No. 42P17342

-1-

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b) of any foreign application(s) for patent, or inventor's or plant breeder's rights certificate(s), or 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent, inventor's or plant breeder's rights certificate(s), or any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application(s):

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Priority Not Claimed	Certified Copy Attached?
			<input type="checkbox"/>	<input type="checkbox"/> Yes <input type="checkbox"/> No
			<input type="checkbox"/>	<input type="checkbox"/> Yes <input type="checkbox"/> No
			<input type="checkbox"/>	<input type="checkbox"/> Yes <input type="checkbox"/> No
			<input type="checkbox"/>	<input type="checkbox"/> Yes <input type="checkbox"/> No
			<input type="checkbox"/>	<input type="checkbox"/> Yes <input type="checkbox"/> No

**Appointment of Practitioners:**

I hereby appoint the practitioners associated with Customer Number: 45209 as my respective patent attorneys and patent agents, with full power of substitution and revocation, to prosecute this application and to transact all business in the U.S. Patent and Trademark Office connected herewith.

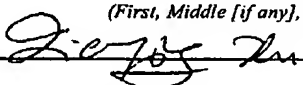
If this patent application is assigned, then the undersigned hereby authorizes the patent attorneys and patent agents named herein to accept and follow instructions from the assignee(s) as to any action to be taken in the United States Patent and Trademark Office regarding this application without direct communication between the patent attorneys and patent agents and the undersigned. In the event of a change in the persons from whom instructions may be taken, at least one patent attorney or patent agent named herein will be so notified by the undersigned.

**Correspondence:**

Direct all correspondence to Customer Number 08791.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

NAME OF SOLE OR FIRST INVENTOR: ☐ A petition has been filed for this undersigned inventor

Full Name: Jianping Xu  
*(First, Middle [if any], Family Name (or Surname), and Suffix [if any])*  
 Inventor's Signature  Date 7/16/2004  
 Residence Portland, Oregon USA Citizenship USA  
*(City, State, Country)* *(Country)*  
 Mailing Address 1529 NW Skocum Way  
Portland, Oregon 97229 USA

Docket No. 42P17342

-2-

NAME OF SECOND INVENTOR: ☐ A petition has been filed for this undersigned inventor

Full Name: Fabrice Paillet  
(First, Middle [if any], Family Name (or Surname), and Suffix [if any])  
Inventor's Signature [Signature] Date 07/16/2004  
Residence Hillsboro, Oregon USA Citizenship France  
(City, State, Country) (Country)  
Mailing Address 1691 NE 64th Avenue  
Hillsboro, Oregon 97124 USA

NAME OF THIRD INVENTOR: ☐ A petition has been filed for this undersigned inventor

Full Name: Tanay Karnik  
(First, Middle [if any], Family Name (or Surname), and Suffix [if any])  
Inventor's Signature \_\_\_\_\_ Date \_\_\_\_\_  
Residence Portland, Oregon USA Citizenship USA  
(City, State, Country) (Country)  
Mailing Address 3574 NW Blackcomb Drive  
Portland, Oregon 97229 USA

NAME OF FOURTH INVENTOR: ☐ A petition has been filed for this undersigned inventor

Full Name: Donald S. Gardner  
(First, Middle [if any], Family Name (or Surname), and Suffix [if any])  
Inventor's Signature \_\_\_\_\_ Date \_\_\_\_\_  
Residence Mountain View, California USA Citizenship USA  
(City, State, Country) (Country)  
Mailing Address 2281 Oaktree Drive  
Mountain View, California 94040 USA

NAME OF FIFTH INVENTOR: ☐ A petition has been filed for this undersigned inventor

Full Name: \_\_\_\_\_  
(First, Middle [if any], Family Name (or Surname), and Suffix [if any])  
Inventor's Signature \_\_\_\_\_ Date \_\_\_\_\_  
Residence \_\_\_\_\_ Citizenship \_\_\_\_\_  
(City, State, Country) (Country)  
Mailing Address \_\_\_\_\_  
\_\_\_\_\_



Title 37, Code of Federal Regulations, Section 1.56  
Duty to Disclose Information Material to Patentability.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information, which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) Prior art cited in search reports of a foreign patent office in a counterpart application, and
- (2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

- (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or
- (2) It refutes, or is inconsistent with, a position the applicant takes in:
  - (i) Opposing an argument of unpatentability relied on by the Office, or
  - (ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) Each inventor named in the application;
  - (2) Each attorney or agent who prepares or prosecutes the application; and
  - (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.
- (d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

(e) In any continuation-in-part application, the duty under this section includes the duty to disclose to the Office all information known to the person to be material to patentability, as defined in paragraph (b) of this section, which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.



<b>DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION</b> <b>(37 CFR 1.63)</b>		Attorney Docket Number	42P17342
		First Named Inventor	Jianping Xu
<input type="checkbox"/> Declaration Submitted with Initial Filing OR <input checked="" type="checkbox"/> Declaration Submitted after Initial Filing (surcharge (37 CFR 1.16(e)) required)		<b>COMPLETE IF KNOWN</b>	
		Application Number	10/816,026
		Filing Date	March 31, 2004
		Art Unit	
		Examiner Name	

As a below named inventor, I hereby declare that:

My residence, mailing address, and citizenship are as stated below, next to my name.

I believe the inventor(s) named below to be the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

**METHOD AND APPARATUS FOR OPTICAL SIGNALING**

(Title of the Invention)

the specification of which

☐ Is attached hereto.

OR

☒ was filed on (if applicable):

or 03/31/2004 as United States Application Number 10/816,026  
PCT International Application Number \_\_\_\_\_

and was amended on \_\_\_\_\_ (if applicable)

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claim(s), as amended by any amendment specifically referred to above.

I do not know and do not believe that the claimed invention was ever known or used in the United States of America before my invention thereof, or patented or described in any printed publication in any country before my invention thereof or more than one year prior to this application. I do not know and do not believe that the claimed invention was in public use or on sale in the United States of America more than one year prior to this application, nor do I know or believe that the invention has been patented or made the subject of an inventor's certificate issued before the date of this application in any country foreign to the United States of America on an application filed by me or my legal representatives or assigns more than twelve months (for a utility patent application) or six months (for a design patent application) prior to this application.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

Docket No. 42P17342

-1-

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b) of any foreign application(s) for patent, or inventor's or plant breeder's rights certificate(s), or 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent, inventor's or plant breeder's rights certificate(s), or any PCT international application having a filing date before that of the application on which priority is claimed.

**Prior Foreign Application(s):**

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Priority Not Claimed	Certified Copy Attached?
			<input type="checkbox"/>	<input type="checkbox"/> Yes <input type="checkbox"/> No
			<input type="checkbox"/>	<input type="checkbox"/> Yes <input type="checkbox"/> No
			<input type="checkbox"/>	<input type="checkbox"/> Yes <input type="checkbox"/> No
			<input type="checkbox"/>	<input type="checkbox"/> Yes <input type="checkbox"/> No
			<input type="checkbox"/>	<input type="checkbox"/> Yes <input type="checkbox"/> No

**Appointment of Practitioners:**

I hereby appoint the practitioners associated with Customer Number: **45209** as my respective patent attorneys and patent agents, with full power of substitution and revocation, to prosecute this application and to transact all business in the U.S. Patent and Trademark Office connected herewith.

If this patent application is assigned, then the undersigned hereby authorizes the patent attorneys and patent agents named herein to accept and follow instructions from the assignee(s) as to any action to be taken in the United States Patent and Trademark Office regarding this application without direct communication between the patent attorneys and patent agents and the undersigned. In the event of a change in the persons from whom instructions may be taken, at least one patent attorney or patent agent named herein will be so notified by the undersigned.

**Correspondence:**

Direct all correspondence to Customer Number **08791**.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

**NAME OF SOLE OR FIRST INVENTOR:** ☐ A petition has been filed for this undersigned inventor

Full Name: Jianping Xu  
(First, Middle [if any], Family Name (or Surname), and Suffix [if any])

Inventor's Signature \_\_\_\_\_ Date \_\_\_\_\_

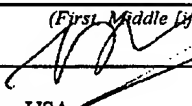
Residence Portland, Oregon USA Citizenship USA  
(City, State, Country) (Country)

Mailing Address 1529 NW Slocum Way  
Portland, Oregon 97229 USA

NAME OF SECOND INVENTOR: ☐ A petition has been filed for this undersigned inventor

Full Name: Fabrice Paillet  
(First, Middle [if any], Family Name (or Surname), and Suffix [if any])  
Inventor's Signature \_\_\_\_\_ Date \_\_\_\_\_  
Residence Hillsboro, Oregon USA Citizenship France  
(City, State, Country) (Country)  
Mailing Address 1691 NE 64th Avenue  
Hillsboro, Oregon 97124 USA

NAME OF THIRD INVENTOR: ☐ A petition has been filed for this undersigned inventor

Full Name: Tanay Karnik  
(First, Middle [if any], Family Name (or Surname), and Suffix [if any])  
Inventor's Signature  Date 7/25/04  
Residence Portland, Oregon USA Citizenship USA  
(City, State, Country) (Country)  
Mailing Address 3574 NW Blackcomb Drive  
Portland, Oregon 97229 USA

NAME OF FOURTH INVENTOR: ☐ A petition has been filed for this undersigned inventor

Full Name: Donald S. Gardner  
(First, Middle [if any], Family Name (or Surname), and Suffix [if any])  
Inventor's Signature \_\_\_\_\_ Date \_\_\_\_\_  
Residence Mountain View, California USA Citizenship USA  
(City, State, Country) (Country)  
Mailing Address 2281 Oaktree Drive  
Mountain View, California 94040 USA

NAME OF FIFTH INVENTOR: ☐ A petition has been filed for this undersigned inventor

Full Name: \_\_\_\_\_  
(First, Middle [if any], Family Name (or Surname), and Suffix [if any])  
Inventor's Signature \_\_\_\_\_ Date \_\_\_\_\_  
Residence \_\_\_\_\_ Citizenship \_\_\_\_\_  
(City, State, Country) (Country)  
Mailing Address \_\_\_\_\_  
\_\_\_\_\_



Title 37, Code of Federal Regulations, Section 1.56  
Duty to Disclose Information Material to Patentability.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information, which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) Prior art cited in search reports of a foreign patent office in a counterpart application, and
  - (2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.
- (b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and
- (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or
  - (2) It refutes, or is inconsistent with, a position the applicant takes in:
    - (i) Opposing an argument of unpatentability relied on by the Office, or
    - (ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

- (c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:
- (1) Each inventor named in the application;
  - (2) Each attorney or agent who prepares or prosecutes the application; and
  - (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.
- (d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.
- (e) In any continuation-in-part application, the duty under this section includes the duty to disclose to the Office all information known to the person to be material to patentability, as defined in paragraph (b) of this section, which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.





<b>DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION (37 CFR 1.63)</b>  <input type="checkbox"/> Declaration Submitted with Initial Filing  <b>OR</b>  <input checked="" type="checkbox"/> Declaration Submitted after Initial Filing (surcharge (37 CFR 1.16(e)) required)	Attorney Docket Number	42P17342
	First Named Inventor	Jianping Xu
	<b>COMPLETE IF KNOWN</b>	
	Application Number	10/816,026
	Filing Date	March 31, 2004
	Art Unit	
Examiner Name		

As a below named inventor, I hereby declare that:

My residence, mailing address, and citizenship are as stated below, next to my name.

I believe the inventor(s) named below to be the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

**METHOD AND APPARATUS FOR OPTICAL SIGNALING**

*(Title of the Invention)*

the specification of which

☐ is attached hereto.

OR

☒ was filed on (if applicable):

or 03/31/2004 as United States Application Number 10/816,026

and was amended on \_\_\_\_\_ PCT International Application Number \_\_\_\_\_  
(if applicable)

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claim(s), as amended by any amendment specifically referred to above.

I do not know and do not believe that the claimed invention was ever known or used in the United States of America before my invention thereof, or patented or described in any printed publication in any country before my invention thereof or more than one year prior to this application. I do not know and do not believe that the claimed invention was in public use or on sale in the United States of America more than one year prior to this application, nor do I know or believe that the invention has been patented or made the subject of an inventor's certificate issued before the date of this application in any country foreign to the United States of America on an application filed by me or my legal representatives or assigns more than twelve months (for a utility patent application) or six months (for a design patent application) prior to this application.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b) of any foreign application(s) for patent, or inventor's or plant breeder's rights certificate(s), or 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent, inventor's or plant breeder's rights certificate(s), or any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application(s):

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Priority Not Claimed	Certified Copy Attached?
			<input type="checkbox"/>	<input type="checkbox"/> Yes <input type="checkbox"/> No
			<input type="checkbox"/>	<input type="checkbox"/> Yes <input type="checkbox"/> No
			<input type="checkbox"/>	<input type="checkbox"/> Yes <input type="checkbox"/> No
			<input type="checkbox"/>	<input type="checkbox"/> Yes <input type="checkbox"/> No
			<input type="checkbox"/>	<input type="checkbox"/> Yes <input type="checkbox"/> No

**Appointment of Practitioners:**

I hereby appoint the practitioners associated with Customer Number: 45209 as my respective patent attorneys and patent agents, with full power of substitution and revocation, to prosecute this application and to transact all business in the U.S. Patent and Trademark Office connected herewith.

If this patent application is assigned, then the undersigned hereby authorizes the patent attorneys and patent agents named herein to accept and follow instructions from the assignee(s) as to any action to be taken in the United States Patent and Trademark Office regarding this application without direct communication between the patent attorneys and patent agents and the undersigned. In the event of a change in the persons from whom instructions may be taken, at least one patent attorney or patent agent named herein will be so notified by the undersigned.

**Correspondence:**

Direct all correspondence to Customer Number 08791.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

NAME OF SOLE OR FIRST INVENTOR: ☐ A petition has been filed for this undersigned inventor

Full Name: Jianping Xu  
(First, Middle [if any], Family Name (or Surname), and Suffix [if any])

Inventor's Signature \_\_\_\_\_ Date \_\_\_\_\_

Residence Portland, Oregon USA Citizenship USA  
(City, State, Country) (Country)

Mailing Address 1529 NW Slocum Way  
Portland, Oregon 97229 USA

Docket No. 42P17342

-2-

NAME OF SECOND INVENTOR: ☐ A petition has been filed for this undersigned inventor

Full Name: Fabrice Paillet  
(First, Middle [if any], Family Name (or Surname), and Suffix [if any])  
Inventor's Signature \_\_\_\_\_ Date \_\_\_\_\_  
Residence Hillsboro, Oregon USA Citizenship France  
(City, State, Country) (Country)  
Mailing Address 1691 NE 64th Avenue  
Hillsboro, Oregon 97124 USA

NAME OF THIRD INVENTOR: ☐ A petition has been filed for this undersigned inventor

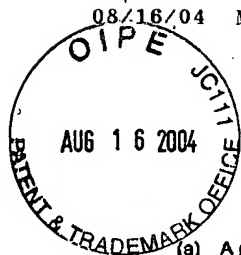
Full Name: Tanay Karnik  
(First, Middle [if any], Family Name (or Surname), and Suffix [if any])  
Inventor's Signature \_\_\_\_\_ Date \_\_\_\_\_  
Residence Portland, Oregon USA Citizenship USA  
(City, State, Country) (Country)  
Mailing Address 3574 NW Blackcomb Drive  
Portland, Oregon 97229 USA

NAME OF FOURTH INVENTOR: ☐ A petition has been filed for this undersigned inventor

Full Name: Donald S. Gardner  
(First, Middle [if any], Family Name (or Surname), and Suffix [if any])  
Inventor's Signature Donald S. Gardner Date July 28, 2004  
Residence Mountain View, California USA Citizenship USA  
(City, State, Country) (Country)  
Mailing Address 2281 Oaktree Drive  
Mountain View, California 94040 USA

NAME OF FIFTH INVENTOR: ☐ A petition has been filed for this undersigned inventor

Full Name: \_\_\_\_\_  
(First, Middle [if any], Family Name (or Surname), and Suffix [if any])  
Inventor's Signature \_\_\_\_\_ Date \_\_\_\_\_  
Residence \_\_\_\_\_ Citizenship \_\_\_\_\_  
(City, State, Country) (Country)  
Mailing Address \_\_\_\_\_  
\_\_\_\_\_



**Title 37, Code of Federal Regulations, Section 1.56  
Duty to Disclose Information Material to Patentability.**

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information, which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) Prior art cited in search reports of a foreign patent office in a counterpart application, and
  - (2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.
- (b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and
- (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or
  - (2) It refutes, or is inconsistent with, a position the applicant takes in:
    - (i) Opposing an argument of unpatentability relied on by the Office, or
    - (ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

- (c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:
- (1) Each inventor named in the application;
  - (2) Each attorney or agent who prepares or prosecutes the application; and
  - (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.
- (d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.
- (e) In any continuation-in-part application, the duty under this section includes the duty to disclose to the Office all information known to the person to be material to patentability, as defined in paragraph (b) of this section, which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.